

The Intellectual Property Section of the State Bar of California presents the

### 33<sup>rd</sup> Annual Intellectual **Property Institute**



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Network, share ideas and learn the latest with Intellectual Property professionals with diverse experience and backgrounds.

A full 2 1/2 days of education for a nominal fee of \$525 for members of the Intellectual Property Section which includes education programs, program materials, Friday and Saturday continental breakfasts and luncheons and the Friday night reception

BONUS CD-Rom provided compliments of the State Bar Lawyer Assistance Program

### **Sponsors:**

The Intellectual Property Section would like to thank the following sponsors for their financial support:

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### Program Chair

Barbara L. Friedman Hanson Bridgett LLP

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### Programs at a glance



Thursday, November 6, 2008				
Track I – Patent	Track II – Trademark	Track III - Copyright		
Nuts and Bolts of Patent Prosecution and Litigation	Nuts and Bolts of Trademark Prosecu- tion and Litigation	Nuts and Bolts of Copyright Prosecu- tion and Litigation		

Track IV – Trademark, Copyright, & Patent Licensing Nuts and Bolts

Friday, November 7, 2008			
TRACK I - Patents	TRACK II - Mixed		
The Trade Secrets Puzzle—General Session			
An Introduction To University/ Start Up Licensing	Blogging into Indifference		
Current Trends in Patent Litigation: A Report From The Front Lines	Current Developments in Copyright Law		
War and Peace: Patent Protection at the Border	Trademark Year in Review		
U.S. Government Coordinated Approach to Intellectual Property Protection and Enforcement—Luncheon Program			
Critical Developments in Patent Law: 2007-2008	Fair Use Solutions: Documentaries and Beyond		
Are Patents, Copyrights and Trademarks Property?—General Session			

Saturday, November 8, 2008			
TRACK I - Patents	TRACK II - Mixed		
Hot Topics in Patent Prosecution	Advertising, Contests, Sweepstakes and Promotions		
Mock Markman Hearing—Part 1	Intellectual Property vs. the First Amendment		
Mock Markman Hearing—Part 2	Does the Trademark Dilution Cause of Action Make Any Difference?		
As the World Turns—Does The DMCA Need One More Revolution?—General Session			

### Schedule of Events



### **THURSDAY, NOVEMBER 6, 2008**

9:00 a.m. – 1:00 p.m.

**Executive Committee Meeting (open meeting)** 

1:00 p.m. – 4:00 p.m.

**Concurrent Sessions** 

TRACK I - PATENTS

**Nuts and Bolts of Patent Prosecution and Litigation** 

(3.00 Hours MCLE Credit)

Attorneys experienced in this field will present a program on the basics of patent prosecution and litigation practice designed for new admittees, practitioners new to the field of patent law, and paralegals.

**Panelists: Bryan Sinclair**, Mintz Levin; **T.J. Singh**, Klein, O'Neill & Singh, LLP

TRACK II - TRADEMARKS

**Nuts and Bolts of Trademark Prosecution** 

and Litigation (3.00 Hours MCLE Credit)

Attorneys experienced in this field will present a program on the basics of trademark prosecution, including clearance and opinion work, prosecution before the U.S. Patent and Trademark office, as well as dilution, domain name disputes, and trademark infringement on the Internet. Designed for new admittees, practitioners new to the field of trademark law, and paralegals.

**Panelists: Sophie Cohen**, Cobalt LLP; **Amanda Nye**, Lawyers at Large LLC

Track III - COPYRIGHTS

Nuts and Bolts of Copyright Prosecution and Litigation (3.00 Hours MCLE Credit)

Attorneys experienced in this field will present a program on the basics of copyright prosecution and litigation practice designed for new admittees, practitioners new to the field of copyright law, and paralegals.

**Panelists: Karen Frank,** Coblentz, Patch, Duffy & Bass; **Anne Hiaring-Hocking,** Law Office of Anne Hiaring

4:00 p.m. – 5:00 p.m.

General Session—Trademark, Copyright, & Patent Licensing Nuts & Bolts (1.00 Hour MCLE Credit)

A panelist experienced in the field will present a program on the basics of intellectual property licensing. Designed for new admittees, practitioners new to I.P. licensing and paralegals.

Speaker: David C. Gurnick, Lewitt Hackman et. al

5:00 p.m. – 6:00 p.m.

Law Student, New Member, & First Time Attendee Reception

6:30 p.m. – 8:30 p.m.

Annual Executive Committee Alumni and Speaker's Reception & Dinner (invitation only)

8:30 p.m. – 10:30 p.m. Kick-off Party Dessert Reception

10:00 p.m. – 12:00 a.m.

Movie Screening "This Film is Not Yet Rated" with the director Kirby Dick.

### FRIDAY, NOVEMBER 7, 2008

7:00 a.m. – 7:45 a.m.

**Continental Breakfast & Conference Registration** 

7:45 a.m. – 8:00 a.m. Opening Remarks

8:00 a.m. – 9:00 a.m.

GENERAL SESSION

The Trade Secrets Puzzle: Putting the Pieces Together In Today's Intellectual Property Climate (1.00 Hour MCLE Credit) With recent changes in patent law, there is a new focus on trade secrets and protection is being extended in new and creative ways. The panel will discuss new developments in trade secret law and the challenges and advantages of trade secret protection, providing perspectives from outside counsel, in-house counsel and the judiciary

Panelists: Deborah Greaves, True Religion Brand Jeans; Karineh Kachatourian, Mintz Levin; The Honorable Socrates Manukian, Judge, Superior Court of California

9:00 a.m. – 10:00 a.m. TRACK I – PATENTS

An Introduction to University/Start-Up Licensing

(1.00 Hour MCLE Credit)

Licensing patents and other intellectual property from universities poses unique challenges, from compliance with federal guidelines to navigating university- specific policies, and from sponsored research arrangements to exclusive licensing deals. This panel discussion will examine issues that often arise in university technology transfer licensing, from both the perspective of the university licensor and the licensee, including special issues faced by start-ups. Topics to be discussed will include: licensing from universities, reserved rights clauses, Bayh Dole and other laws, avoiding licensing mistakes that deter later collaborations or acquisitions, negotiating sponsored research agreements, structuring win-win start-up agreements, stock consideration, and conflicts of interest in faculty-founded start-ups.

Panelists: Scott Carter, Latham & Watkins; Rita Hao, University of California

TRACK II - MIXED

Blogging into Indifference (1.00 Hour MCLE Credit)

Benefits, Barriers and Bombshells: Blogs are a cutting edge communication tool for attorneys. They are the next generation in a rapidly morphing media evolution. Those who learn to use them effectively are most likely to survive and thrive in this modern world. But blogs can cut both ways: marketing goldmines and mine fields of lurking liability. Join us for this exciting, interactive talk to gain valuable insight into the benefits of blogging, the barriers to entry, and how to avoid those pesky liability bombshells. Enter the blogosphere: no special equipment required; ability to duck and cover strongly recommended.

Speaker: Jonathan Pink, Bryan Cave

10:00 a.m. – 10:15 a.m. BREAK

10:15 a.m. – 11:30 a.m.

TRACK I—PATENT

**Current Trends in Patent Litigation: A Report From The Front Lines** (1.25 Hours MCLE Credit)

As the Supreme Court and Federal Circuit continue to remake the basic rules of the road, our panel will examine the impact of these changes on the front lines of patent litigation today. As

### Schedule of Events

### FRIDAY, NOVEMBER 7, 2008 (cont.)

recent decisions have affected such diverse issues as the scope of patentable subject matter, divided infringement, availability of indirect infringement, standards of proof for obviousness, renewed vigor of § 112, ¶ 1 defenses, and the availability of injunctive relief, strategies for achieving your client's objectives at trial have never been more important. This panel will address such key considerations as pre-litigation negotiations, where to file when litigation becomes inevitable, and best practices for developing and proving your case

Panelists: Jeff Chanin, Keker & Van Nest; Jim Dowd, Wilmer Hale

### TRACK II - MIXED

### **Current Developments in Copyright Law**

(1.25 Hours MCLE Credit)

A review of approximately 20 of the most significant copyright decisions from the past 12 months, with many audio and visual examples. Topics will include: the controversy over the "making available" right in online file-sharing cases; whether photographs of copyrightable 3D objects are derivative works; termination of rights in "Superman"; punitive damages in copyright cases; the Second Circuit ban on retroactive licenses and assignments; the unauthorized use of John Lennon's "Imagine" in a documentary and other recent fair use decisions.

Panelist: Robert Clarida, Cowan, Liebowitz, and Latman

### 11:30 a.m. – 12:30 p.m.

### **TRACK I-PATENT**

### War and Peace: Patent Protection at the Border

(1.00 Hour MCLE Credit)

International commerce raises special patent concerns. The weak dollar favors exports, but China remains a huge source of U.S. goods. Our panelists will discuss ITC actions, strategies for foreign patent filing, enforcement in foreign countries, the Supreme Court's decision last year in AT&T v. Microsoft, and foreign outsourcing.

Panelists: Luke Dauchot, Kirkland & Ellis LLP; Steven Sereboff, SoCal IP Law Group

### **TRACK II-MIXED**

**Trademark Year in Review** (1.00 Hour MCLE Credit) The speaker will survey the year's noteworthy trademark decisions and developments, and the foreseeable impact of these developments.

Speaker: John Welch, Lowrie, Lando & Anastasi, LLP

### 12:45 p.m. – 2:00 p.m.

### **Luncheon & Keynote Program**

### U.S. Government Coordinated Approach to Intellectual **Property Protection and Enforcement**

(1.00 Hour MCLE Credit)

Few issues are as important to the current and future economic strength of the United States as our ability to create and protect intellectual property. The theft of American intellectual property strikes at the heart of one of our greatest comparative advantages—our innovative capacity. Global intellectual property theft and trade in fakes and pirated materials have continued to grow, endangering innovative and creative economies around the world. Counterfeiting

has developed into a massive, sophisticated global business involving the manufacture and sale of counterfeit goods touching nearly every industry. It threatens America's economy, jeopardizes the health and safety of consumers around the world, and bolsters organized criminal networks. The Office of the U.S. Coordinator for International Intellectual Property Enforcement, established in 2005, works to leverage the capabilities and resources of the United States to promote effective global enforcement of intellectual property rights. Under the leadership of the White House, the Coordinator's Office leads inter-agency initiatives such as the Strategy Targeting Organized Piracy (STOP!) and outreach with the private sector and our international partners.

Speaker: Wayne Pugh, Acting U.S. Coordinator for International Intellectual Property Enforcement, Office of the Secretary, U.S. Department of Commerce

### 2:00 p.m. – 2:15 p.m. BREAK

### 2:15 p.m. – 3:30 p.m. TRACK I - PATENTS

### **Current Developments in Patent Law: 2007-2008**

(1.25 Hour MCLE Credit)

A panel discussion of the significant opinions concerning patent law rendered by the Federal Circuit and Supreme Court since the fall of 2007.

Panelists: Michael Edelman, Paul Hastings, LLP; Bryan Sinclair, Mintz Levin

### TRACK II - MIXED

### Fair Use Solutions: Documentaries and Beyond

(1.25 Hours MCLE Credit)

Fair use is famously murky and gray. Or so they say. In reality, there is good news about this venerable doctrine. This panel will explore several solutions to the fair use conundrum: how can I help a client use unlicensed content while keeping risk manageable? Explore fair use dilemmas and solutions from the legal and creative side with fair use experts and noted filmmakers Kirby Dick and Gordon Quinn.

Panelists: Anthony Falzone, Stanford Law School; Peter Jaszi, American University Washington College of Law; Kirby Dick, Director of "This Film is Not Yet Rated"; Gordon Quinn Director of "Hoop Dreams" (invited)

### 3:30 p.m. – 5:00 p.m. **GENERAL SESSION**

### Are Patents, Copyrights and Trademarks Property? A Debate (1.50 Hour MCLE Credit)

For many years, there has been a split in the IP Bar regarding the principles underlying IP law. On one side are those who believe that copyrights, trademarks, and patents constitute a recognition by government of the author/creator/ inventor's natural rights, and furthermore that these natural rights take the form of a strong right to exclude known as "property." On the other side are those who believe the term "property" is a misnomer. Rather they see copyright, patents, and trademarks as sets of legal privileges which the government empowers so-called "owners" to wield solely as stewards for the public interest. The question of "property" has cutting-edge effects in all areas of IP. The role of the public interest in copyright fair use decisions has gained new attention. And the Supreme Court's recent decision in a patent case, eBay, also elevates the public interest as a consideration in the remedies phase of IP litigation. The property debate is particularly powerful in the trademark area, where developments in trademark dilution and infringement law have spawned new powers for certain trademark holders regardless of likelihood of confusion. Join us for a fascinating debate among the experts—and you decide.

**Moderator: William Gallagher**, Golden Gate University

Panelists: Andrew Bridges, Winston Strawn LLP; David Franklyn, University of San Francisco; Wendy Gordon, Boston University School of Law; Scott Kieff, Washington University School of Law (invited)

6:30 p.m. – 9:00 p.m.

**BBQ Dinner** 

(Complimentary, indicate attendance on registration form)

9:00 p.m. – 12 midnight

**Monte Carlo Casino Night** 

Let the gaming begin, 'cause you're playing to win! Nothing beats the heart-pounding excitement of real life casino action. Guests will enjoy blackjack, craps, roulette, and Texas hold'em. Of course it's not real gambling. It's all for fun! Complimentary (indicate attendance on the registration form)

### SATURDAY, NOVEMBER 8, 2008

7:30 a.m. – 4:00 p.m. Registration

8:00 a.m. - 9:00 a.m. **Continental Breakfast** 

9:00 a.m. – 10:00 a.m. **TRACK I - PATENTS** 

> **Hot Topics in Patent Prosecution** (1.00 Hour MCLE Credit) The panel will discuss the impact of KSR International Co.. v. Teleflex Inc.; the pros and cons of accelerated examination and pre-appeal conferences; an update on the First Office Action Interview Pilot Program at the USPTO, strategies for Examiner interviews; and inequitable conduct after McKesson Information Solutions, Inc. v. Bridge Medical, Inc.

> Panelists: Nicholas P. Godici, Birch, Stewart, Kolasch & Birch, LLP; **T.J. Singh**, Klein, O'Neill & Singh

TRACK II - MIXED

**Advertising, Contests, Sweepstakes, and Promotions** 

(1.00 Hours MCLE Credit)

From green marketing to cause promotions, to reverse auction sweepstakes, promotions are big business.

This presentation focuses on recent developments in the

areas of contests, sweepstakes, coupons, rebates, and commercial co-venturing law, and addresses issues pertaining to creating successful and legal campaigns using new technologies and practices such as text messaging, internet reverse-auctions, and pooled promotions.

Speaker: Tsan Abrahamson, Cobalt LLP

10:00 a.m. – 12:45 p.m. TRACK I - PATENT

> Mock Markman Hearing (2.5 Hours MCLE Credit) Attend a mock Markman hearing based on an actual case, SAES Getters S.p.A. v. Aeronex, Inc. The panel will offer a multimedia live presentation of the gladiatorial combat and highlight how extrinsic evidence may be appropriately used in claim interpretation. In addition, the case shows how even when a claim term is defined in the patent, it may nevertheless not be so limited.

> Panelists: The Honorable Lourdes Baird; Breton Bocchieri, Thelen Reid; Michael Lachuk, Science Applications International Corporation; Gilbert Calvillo, Forensic and Litigation Consulting; Vineet M. Dua; Tim Langdel, National University

10:00 a.m. – 11:15 a.m. TRACK II—MIXED

> **Intellectual Property vs. the First Amendment** (1.25 Hours MCLE Credit)

What happens when copyright, the right of publicity, and trademark overlap with the First Amendment's protection of free speech? This panel explores that conflict and proposes some means for addressing it through legislation and the courts.

Panelists: William Gallagher, Golden Gate University; Neil Netanal, UCLA School of Law; Lisa Ramsey, University of San Diego, School of Law

11:15 a.m. – 11:30 a.m. BREAK

11:30 a.m. – 12:45 p.m. TRACK II—MIXED

Does the Trademark Dilution Cause of Action Make Any

**Difference?** (1.25 Hours MCLE Credit)

Empirical Evidence from the Trademark Dilution Revision Act Case Law

Panelists: Barton Beebe, Cardozo School of Law; David Franklyn, University of San Francisco; Michael Grow, Arent Fox

12:45 p.m. – 1:30 p.m.

**Standing Committee Luncheon Meetings** 

Each Standing Committee meeting listed below is open to any Institute registrant. Please select the committee luncheon you wish to attend by checking the appropriate box on the regis-

Patent Law, Licensing, Copyright Law



### Schedule of Events

### SATURDAY, NOVEMBER 8, 2008 (cont.)

1:30 p.m. – 2:15 p.m.

**Standing Committee Luncheon Meetings** 

Computer Law, Trade Secret Law, Trademark Law, Litigation

2:15 p.m. – 3:45 p.m.

As the World Turns—Does the DMCA Need One More Revolution? (1.5 Hours MCLE Credit)

The Digital Millennium Copyright Act was signed into law on October 28, 1998. Among its key provisions were additions to the Copyright Act to address the perceived impact of digital technology on copyright protected content. Considered revolutionary at the time, the Act has been hailed as a critical tool in the fight against modern day piracy and criticized as an over

reaching grab of rights by content owners. Also nestled into the DMCA, but not nearly as controversial, are limitation on liability for online service providers. A decade later, and against the backdrop of this veritable soap opera of comment and critique, this panel presents several key players who will discuss whether the DMCA has achieved its stated goals of protecting content or improperly altered the intended balance of rights between content owners, content users and those who create, distribute and support the technology to deliver the content. Is the DMCA on track, does it need to be tweaked, or is copyright law in need of another revolution?

**Panelists: Dean Garfield**, Motion Picture Association of American; **Jonathan Potter**, Digi Media Association; **Jennifer Urban**, USC Gould School of Law



### Registration Information

### Friday, November 7, 2008 Guest Recreation 9:00 a.m. – 2:00 p.m.

First, it's off to the Palm Springs Aerial Tramway . . . imagine being whisked away from the desert floor 8,516 feet to the top of a magnificent mountain on the world's most spectacular aerial ride! The Palm Springs Aerial Tramway is the largest double reversible tramway in the world with each of its cable cars capable of carrying 80 passengers at one time. Once atop the peak of Mt. San Jacinto, guests will find themselves in a 13,000 acre Wilderness State Park with a magnificent pine forest and a view stretching miles to the Salton Sea. A delightful way to relax after a morning of discovery is to indulge in lunch at one of the most spectacular views in Southern California as you dine at the Top of the Tram Restaurant. \$75/person

### **Registration Information:**

The Intellectual Property Section welcomes all who are interested in Intellectual Property. You need not be a lawyer to attend, enjoy and benefit from this program.

### **Registration Fees:**

Registration fees include admission to 17 hours of MCLE instruction, course materials, continental breakfasts, luncheons and the Friday evening reception

### **Program Chair**

Barbara L. Friedman, Hanson Bridgett LLP

### **Planning Committee**

Warren Dranit, Spaulding McCullough & Tansil LLP J. Alison Grabell, Venable LLP Christine L. Kopitzke, Attorney at Law James D. Nguyen, Foley & Lardner LLP

### **Special Assistance:**

Please call (415) 538-2393. for special assistance or TDD (415) 538-2231 for speech and hearing impaired.

### **Cancellations:**

All requests for refunds must be received in writing no later than October 31, 2008. Refunds will be issued less a \$50 non-refundable administrative cost. Refunds will not be available after the October 31st deadline; however, registration substitutions will be accepted.

### **Hotel Reservations at Rancho Las Palmas**

We have reserved a limited block of sleeping rooms at Rancho Las Palmas, 14000 Bob Hope Drive, Rancho Mirage, California 92270. Please contact the hotel directly at 866-423-1195 to make your reservation. Please identify yourself as part of the State Bar of California Intellectual Property Institute to obtain the special rate of \$199 single/double plus occupancy tax per night. Please make your reservation by **October 13**, **2008**. Reservations made after the **October 13**, **2008** deadline will be made on a space available basis at the confirmed group rate.

### **Information:**

For more information, please call the Intellectual Property Section at (415) 538-2393. For registration information, please call Program Registrations at (415) 538-2508.



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33<sup>rd</sup> Annual Intellectual Property Institute November 6-8, 2008

### Registration Form

Registration Deadline: October 31, 2008

### **Three Ways to Register!**

**Online:** Register online by visiting www.calbar.ca.gov/ipsection

**Fax:** You may fax your registration form to Program registrations at (415) 538-2368. All faxed registrations must be accompanied by a signature and MasterCard or VISA card number.

**Mail:** Mail registration form and check made payable to the State Bar of California or credit card information to: Program Registrations, The State Bar of California, 180 Howard Street, San Francisco, CA 94105.

100 Howard Street, Jan Hancisco, CA 34103.	
Note: One registrant per form. Photocopies may be used	
Bar Number:	
Name:	
Firm Name:	
Firm Address:	
City, State & Zip:	
Phone:	
Fax:	
E-mail:(Required for e-mail confirmation)	
Guest:	
(Note: if your guest is a non-attorney, registration is complimentary. Attorney guests must complete a separate registration form and pay the appropriate registration fee.)	
O Check here if you do not want your information released to other IP Institute attendees and exhibitors/vendors.	
<b>Registration Fees</b> (check the appropriate box):	
\$525 IP Section Members	
O \$600 Non-Members of the Intellectual Property Section	

(includes enrollment in the Intellectual Property Law Sec-

\$225 Law School Faculty/Paralegal/Government/ Non-Profit

O \$600 All registrations after October 31, 2008

tion for 2009)

O \$ 50 Law Students

**Subtotal of Registration Fees** 

### **Special Events:** Sign up for Nuts & Bolts O Track I—Patent FREE FREE O Track II—Trademark ○ Track III—Copyright FREE Track IV—Licensing FREE **Thursday Night Kick Off Party** O I will attend (# in party) \$ FREE This Film is Not Yet Rated, Movie Evening O I will attend \_\_\_\_(# in party) \$ FREE Sign up for Tram (Number in party) @ \$75/each = **Friday Luncheon (free for PAID registrants)** O I will attend (Guests in party) @ \$40/guest = Friday Night BBQ (free for PAID registrants) O I will attend \$ FREE (Guests in party) @ \$50/guest =**Monte Carlo Casino Night** O I will attend (# in party) \$ FREE **Saturday Committee Luncheon** O I will attend \$\_FREE\_ (indicate which Committee luncheon you will attend) O Copyright Law O Computer Law O Legislation O Licensing O Patent Law O Trademark O Trade Secret O Litigation **Subtotal of Special Events Fee Total Amount Enclosed or to be charged \$ Payment Method:** Registration fees may be paid by check, VISA or MasterCard. No other credit cards will be accepted. Make checks payable to the State Bar of California. O VISA O MasterCard Account Number: Expiration Date: Cardholder's Name: Cardholder's Signature:

FOR REGISTRATION INFORMATION PLEASE CALL (415) 538-2508



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**Program Date:** 

November 6-8, 2008

Hotel Registration Deadline: October 13, 2008

Registration Deadline: October 31, 2008

